

### REMARKS

Claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, and 24 are all the claims pending in the application. Claims 2, 4, 7, 10, 12, 15, 18, 20, and 23 have been previously canceled without prejudice or disclaimer. Claims 1, 5, 9, 13, 17, and 21 are amended herein. No new matter is being added. Claims 1, 9, and 17 stand rejected on informalities. Claims 1, 3, 5-9, 11, 13-17, 19 and 21-24 stand rejected on prior art grounds. Applicants respectfully traverse these rejections based on the following discussion.

#### **I. The 35 U.S.C. §112 Rejections**

Claims 1, 9, and 17 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, claims 1, 9, and 17 stand rejected, because, according to the Advisory Action, "[t]he composition of dynamic negotiations is made not clear by the wherein clauses affixed to the end of the claim." As such, Applicants have amended claims 1, 9, and 17 to more clearly articulate the composition of the dynamic negotiations. Accordingly, a dynamic negotiation comprises any of said customers requesting said resource center to acquire and release resources at any time; said resource center conducting an auction of all available resources in a shared resource pool at predetermined intervals to determine said allocation and pricing of said resources for a subsequent time interval; and said resource center publishing said prices at which said resources of said shared resource pool can be acquired or released by said customers, whereby said customers use said prices for determining whether to request releasing or acquiring said resources.

Furthermore, the Advisory Action indicates that there is insufficient antecedent basis for

the limitation "software-based agents" in claims 1, 9, and 17. Accordingly, Applicants have amended claims 1, 9, and 17 to provide proper antecedent basis for the limitation "software-based agents" in accordance with the suggestion by the Examiner during a telephone discussion on March 21, 2005 with the undersigned attorney.

Applicants note that the 35 U.S.C. §112, second paragraph rejections to claims 1, 9, and 17 are new rejections having never been made previously. As such, because these rejections are new, and could have been previously made prior to the Advisory Action of March 20, 2005, Applicants respectfully request that the rejection to the claims be made non-final because the final rejection is premature. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

## **II. The Prior Art Rejections**

Claims 1, 3, 6-9, 11, 14-17, 19 and 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Miller, et al. (U.S. Patent No. 5,640,569), hereinafter referred to as "Miller", in view of Krishnaswamy, et al. (U.S. Patent No. 5,867,494), hereinafter referred to as "Krishnaswamy", in view of Gray, et al. (U.S. Publication No. 2002/0082856 A1), hereinafter referred to as "Gray", and in further view of Ferstenberg, et al. (U.S. Patent No. 5,873,071), hereinafter referred to as "Ferstenberg". Claims 5, 13 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Miller and Krishnaswamy, in view of Ferstenberg. Applicants respectfully traverse these rejections based on the following discussion.

Amended independent claims 1, 9 and 17 contain features not rendered obvious by the combined prior art references of record. Particularly, independent claims 1, 9, and 17 generally include the additional features, "enabling the customers to provide price and service level related

inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained, ... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center." By incorporating such a feature in the independent claims, all four prior art references of record, namely, Miller, Krishnaswamy, Gray, and Ferstenberg, as well as the precepts taken as Official Notice, would have to be combined in various combinations with one another in order to try and teach, but failing nonetheless, the amended claimed language.

More particularly, with regard to the Official Notice, which was previously taken on page 6 of the Office Action of December 22, 2004, the Advisory Action indicates that the principles taken as Official Notice are taught in Miller and Krishnaswamy. However, Applicants are confused as to this conclusion reached in the Advisory Action because it is directly contradictory to the position taken on page 6 of the Office Action of December 22, 2004, which states:

With regard to the limitation of each class of resources has some units dedicated to specific customers and the remaining units can be dynamically allocated to customers by the resource center, the combination of Miller/Krishnaswamy, as shown above, discloses various auction techniques. Miller/Krishnaswamy do not specifically state that certain resources are set aside for certain customers.

Thus, it now appears that it is the position of the Examiner that his earlier statements were erroneous. Clearly, if this is the case, then Applicants are being unfairly prejudiced by the inconsistencies in the Examiner's conclusions, which further favors withdrawal of the finality of the rejections. Moreover, while Krishnaswamy discloses billing methods, there is no teaching in Krishnaswamy that each class of resources has some units dedicated to specific customers.

Thus, the conclusion reached in the Advisory Action that Krishnaswamy's billing methods are

analogous and equivalent to the claimed invention are erroneous.

For at least the reasons previously discussed in Applicants' amendment of January 25, 2005, Applicants respectfully submit that none of Miller, Krishnaswamy, Gray, Ferstenberg, or the concepts taken as Official Notice, alone or in combination, disclose, teach or suggest, including as recited in independent claim 1, and similarly independent claims 9 and 17, of Applicant's invention, including "enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained.... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center."

Indeed, Applicant submits that at least four separate and distinct references as well as concepts identified as Official Notice have been arbitrarily "lumped" together in an attempt to disclose Applicant's invention. Insofar as references may be combined to teach a particular invention, and the proposed combination of Miller, Krishnaswamy, Gray, Ferstenberg, and concepts identified as Official Notice, in various combinations with one another, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C.

1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicant's novel claimed invention. Furthermore, the claimed invention, as amended, meets the above-cited tests for obviousness by including embodiments such as "...enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained, ... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center" as generally recited in amended claims 1, 9, and 17. As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Miller fail to disclose all of the elements of the claims

of the present invention, particularly, the dynamic allocation of resources and the manner of customer and resource center negotiations, as discussed above, but also, if combined with Krishnaswamy, Gray, Forstenberg, and concepts identified as Official Notice fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Miller, alone or in combination with Krishnaswamy, Gray, Forstenberg, and/or concepts identified as Official Notice teaches a structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

In view of the foregoing, the Applicant respectfully submits that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 9, and 17 and as such, claims 1, 9, and 17 are patentable over Miller alone or in combination with Krishnaswamy, Gray, Forstenberg, and/or concepts identified as Official Notice. Further, dependent claims 3, 5-6, 8, 11, 13-14, 16, 19, 21-22, and 24 are similarly patentable over Miller alone or in combination with either Krishnaswamy, Gray, Forstenberg, and/or concepts identified as Official Notice, not only by virtue of their dependency from patentable independent claims,

respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Moreover, the Applicant notes that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

### III. Formal Matters and Conclusion

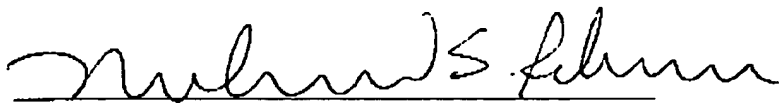
With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, and 24, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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